

REMARKS/ARGUMENTS

Before addressing the restriction requirement, the undersigned would like to thank Examiner Barot for courtesies extended during a brief telephone discussion of the restriction requirement on December 3, 2004.

The applicants elect, with traverse, claims 1-20 and 25-34 of Group I, which the Examiner indicated are drawn to a system and method for generating traffic information for analysis, classified in Subclasses 238-242 of Class 709.

The applicants believe that the restriction requirement is improper for at least two reasons. First, since the claims are to a product (i.e., a stored data structure), a process for making the product, and a process for using the product, where the process of making and the product are not distinct, the claims should be joined. Second, it would not be a serious burden on the Examiner to examine all of the claims. Each of these issues is addressed below.

1. *Rule 141(b) is Applicable and Requires that All Claims be Examined*

The claims are to a product (claims 37-40 are to data structures stored on a machine readable medium), a process for making the product (claims 21-24, 35 and 36 are to methods and means for generating a stored data structure, such as the ones recited in claims 37-40), and a process for using the product (claims 1-20 and 25-34 are to methods and apparatus that can use a data structure, such as the ones recited in claims 37-40). The process of making the stored data structure and the stored data structure are not

distinct, which is implied by the Examiner grouping the claims together in Group II.

Given the foregoing facts, 37 C.F.R. § 1.141(b) is applicable. More specifically, this rule states:

(b) Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. **If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.** [Emphasis added.]

Under this rule, the restriction requirement is improper.

During the telephone discussion, the Examiner contended that the claims in the two groups were to a combination-subcombination. Without addressing the merits of this conclusion, the applicants respectfully note that Rule 141(b) clearly specifies that the claims should be joined "even though a showing of distinctness between the product and process of using the product can be made." The Examiner also noted that Rule 141(b) is normally used in the context of chemical applications. Even assuming, arguendo, that this is true, there is nothing in Rule 141 that limits its applicability to chemical inventions. Accordingly, the claims were not properly restricted for at least the foregoing reason.

2. Examining Both Groups Would Not be a "Serious Burden"

It would not be a serious burden on the Examiner to examine all of the claims. MPEP 803 provides that there are two criteria for proper restriction between patentably distinct inventions, one of which is that "[t]here must be a serious burden on the examiner if restriction is required." In this instance, the Examiner concluded that the claims of Group I are classified in Subclasses 238-242 of Class 709. The applicants note that Subclasses 238-242 fall under Subclass 200. (See classification manual, page 709-1.) Note (2) of Subclass 200 provides that if computers perform data processing in addition to transferring data therebetween (which is the case here), the search class 707 should also be considered. (See classification manual, pages 709-5 and 709-7.) Thus, since an examination of the claims of Group I should include a search of class 707, and since the claims of Group II includes a search of class 707 according to the Examiner, there would not be a serious burden on the Examiner to examine the claims of both Groups I and II. Accordingly, the claims were not properly restricted for at least this additional reason.

3. Claim Amendments

Non-elected independent claims 21, 35 and 37 have been amended to recite that "the first and second data structures may be used for generating traffic information for analysis." The Examiner suggested that such an

amendment might, upon further consideration, obviate the basis for the restriction requirement. Although the applicants do not believe, for the reasons stated above, that such an amendment is necessary to obviate the restriction requirement, they have nonetheless amended the claims to provide an additional reason to withdraw the restriction requirement.

Conclusion

In view of the foregoing, the applicants respectfully submit that the Examiner should reconsider and withdraw the outstanding restriction requirement, and consider the claims of Group II (claims 21-24, and 35-40).

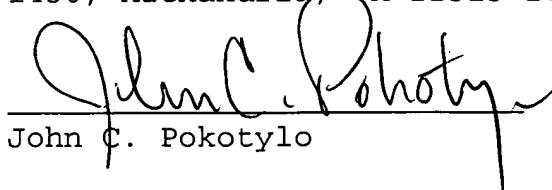
Respectfully submitted,


John C. Pokotylo, Attorney
Reg. No. 36,242
Tel.: (732) 542-9070

December 8, 2004

CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on **December 8, 2004** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


John C. Pokotylo

36,242
Reg. No.